

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MARCH 18, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diane Von Furstenberg Studio

Serial No. 74/570,013

Howard Aronson of Lackenbach Siegel Marzullo Aronson &
Greenspan, P.C. for Diane Von Furstenberg Studio.

Jeffrey Look, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Sams, Simms and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Diane Von Furstenberg Studio has filed an application
to register the mark CASUAL CHIC for handbags, knapsacks,
tote bags, belt bags in the nature of waist packs, suitcases
and luggage in class 18; and men's and women's wearing
apparel, namely, coats, jackets, vests, shawls, sweaters,
hats, tops, shirts, skirts, pants, belts, shoes and boots in
class 25.¹

¹ Application Serial No. 74/570,013 filed September 6, 1994;
alleging dates of first use and first use in commerce of August

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to the goods in class 25, so resembles each of the following marks, which are owned by the same entity for the indicated goods, as to be likely to cause confusion:

(a) "CHIC" (typed letters) which is registered for women's clothing, namely, tops comprised of blouses, woven and knitted sleeved and sleeveless shirts, sweatshirts and jackets;²

(b) "CHIC" BY H.I.S" which is registered in the stylized form reproduced below

The logo consists of the word "chic" in a large, flowing, cursive script. Below it, the words "BY H.I.S" are written in a smaller, bold, sans-serif font. The "H.I.S" is particularly prominent and bold.

for ladies' panties, crop tops, tank tops and coordinated teddys;³ women's foundation garments, brassieres, girdles, women's undergarments consisting of a brassiere and a panty constructed together as one piece and control panties that specifically coordinate with the foregoing; and coordinated teddys;⁴

(c) "CHIC" which is registered in the stylized form reproduced below

26, 1994. The word "CASUAL" has been disclaimed apart from the mark as shown.

² Registration No. 1,349,508 issued July 16, 1985; Sections 8 & 15 affidavit filed.

³ Registration No. 1,663,798 issued November 5, 1991.

⁴ Registration No. 1,769,351 issued May 4, 1993.

The word "chic" is written in a large, elegant, cursive script. The letters are fluidly connected, with a prominent 'c' and a long, sweeping 'i'.

for ladies' and girls knit hosiery, knit headbands, leg warmers and wristbands⁵; women's foundation garments, brassieres, girdles, women's undergarments consisting of a brassiere and a panty constructed together as one piece and control panties, women's daywear; namely, full slips, half slips, camisoles and panties that specifically coordinate with the foregoing; and coordinated teddys⁶; ladies', girls', infants' and toddlers' sheer hosiery and knee highs, including opaque tights up to 70 denier⁷; athletic shoes⁸; ladies' panties, crop tops, tank tops and coordinated teddys⁹; sets and coordinates consisting of tops and and girls' knit and woven separate tops, bottoms and dresses, shortalls and overalls;¹⁰ and

(d) "CHIC SPORTSWEAR FOR THE NATURAL WOMAN" (typed letters) which is registered for women's clothing; namely, jeans; woven pants; knit pants; woven tops; knit tops; sweaters; activewear; namely, sweat shirts, sweat jackets and sweat pants; blazers; T-shirts; and hosiery; namely, socks and tights.¹¹

We note that the Examining Attorney also finally refused registration of the class 18 goods in view of

⁵ Registration No. 1,759,193 issued March 16, 1993.

⁶ Registration No. 1,750,797 issued February 2, 1993.

⁷ Registration No. 1,760,707 issued March 23, 1993.

⁸ Registration No. 1,784,869 issued July 27, 1993.

⁹ Registration No. 1,802,754 issued November 2, 1993.

¹⁰ Registration No. 1,870,618 issued December 27, 1994.

Registration Nos. 1,614,781 and 1,614,782, owned by the same entity. However, since such registrations have been canceled under Section 8, the refusal to register on this basis will be not be given further consideration.

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.

At the outset, we note that applicant concedes that the parties' goods are identical or otherwise closely related. (Brief, p. 3) Thus, we turn our attention, as have applicant and the Examining Attorney, to a consideration of the marks.¹²

Applicant maintains that when the marks are considered in their entirety, they create different commercial impressions. Applicant argues that the word "CASUAL" in its mark cannot be ignored. In particular, applicant states:

Applicant's CASUAL CHIC mark, for use in connection with clothing and other fashion items, is distinctive and unique. Essentially, it is a clever oxymoron, designed to simultaneously convey a contradicting and conflicting message. CASUAL implies informality, a relaxed mood, happenstance.

¹¹ Registration No. 1,833,369 issued April 26, 1994.

¹² During the prosecution of this case, the Examining Attorney argued not only a likelihood of confusion vis-a-vis applicant's mark CASUAL CHIC and each of the registered marks, but that registrant owned a family of CHIC marks and that applicant's mark CASUAL CHIC was likely to cause confusion with registrant's family of CHIC marks. However, the Examining Attorney expressly withdrew the likelihood of confusion argument with respect to a family of CHIC marks in his appeal brief, and thus we have given no consideration to applicant's argument in response thereto in its brief.

CHIC, on the other hand, conveys style, elegance, attention to detail, and sophistication. A person would not ordinarily think to dress CASUALLY if she wanted to be perceived as CHIC. This special meaning, this juxtaposition of conflicting moods is the essence of Applicant's mark.

The distinct message conveyed by Applicant's mark is new, fresh, and unique. H.I.S. Licensing's marks simply do not embody or even remotely convey this message. (Brief, p. 6)

While we have carefully considered applicant's argument, we are not persuaded that CASUAL CHIC and CHIC engender such different commercial impressions as to preclude likelihood of confusion. Rather, due to the shared presence of the word CHIC, applicant's mark CASUAL CHIC and registrant's CHIC marks, all connote a similar theme of stylishness.¹³ We disagree with applicant's contention that CASUAL CHIC conveys a "contradicting and conflicting message." Clothing which is designed for informal occasions may nevertheless be stylish. In this case, we believe that purchasers familiar with registrant's CHIC marks would be likely to assume, upon encountering clothing bearing the mark CASUAL CHIC, that the mark is simply a

¹³ We judicially notice the following definition of "chic" taken from Webster's New World College Dictionary, 3d. (1997): smart elegance of style and manner; said esp. of women and their clothes--*adj.* stylish in a smart, pleasing way. In the same dictionary, "casual" is defined, in relevant part, as: shoes, clothes, etc. designed for informal occasions.

variation of registrant's CHIC marks used to designate a particular line of clothing made by registrant. See Henry Siegel Co. v. M & R International Mfg. Co. 4 USPQ2d 1154 (TTAB 1987) [Purchasers familiar with petitioner's CHIC mark are likely to assume, upon encountering women's clothing bearing the mark L.A. CHIC, that such mark is simply a variation of CHIC mark used to designate a line of clothing made by petitioner in Los Angeles or style prevalent there.] Further, the wording "by H.I.S." and SPORTSWEAR FOR THE NATURAL WOMAN which appear in two of registrant's marks does not significantly change the overall commercial impression projected by these marks, which are dominated by the presence therein of CHIC.

Finally, applicant argues that the word "chic" is highly suggestive or otherwise weak as an element of marks for clothing and fashion items, and thus registrant's CHIC marks are entitled to only a limited scope of protection. In support of its position, applicant submitted a list of registrations it obtained from a commercial database of registration information. The list contains information concerning a number of registrations for marks which consist of or include the word "chic" or its phonetic equivalent for clothing.

As the Examining Attorney points out, however, simply submitting a list of registrations does not make the

registrations of record. Only submission of copies of such registrations would have made them of record. In re Duofold Inc., 184 USPQ 638 (TTAB 1974). Moreover, even if copies had been submitted and the registrations were in agreement with the list provided by applicant, such third-party registrations, which are not evidence that the marks therein are in actual use, would have little probative value on the issue of whether confusion is likely in this case. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). The registrations would, however, be competent to show that others in the field have adopted and registered marks containing the word "chic," and that as used in many of them, the word projects its dictionary meaning of "smart elegance of style and manner." Here, notwithstanding any alleged weakness in the word "chic", each of the registered CHIC marks is still substantially similar in appearance and commercial impression to applicant's mark CASUAL CHIC.

Accordingly, we conclude that purchasers and prospective customers familiar with registrant's CHIC marks for clothing, would be likely to believe, upon encountering applicant's substantially similar mark CASUAL CHIC for the identical or otherwise closely related goods, that the goods emanate from or are associated with or sponsored by the same source.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.

J. D. Sams

R. L. Simms

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board